REMARKS

Claims 6 and 16-76 are pending in this reissue application. Claims 67-76 have been added. Support for these claims can be found, for example, at col. 3, lns. 16-18; col. 3., lns. 18-20; col. 3, lns. 16-18; col. 4, lns. 42-44; col. 4, lns. 42-45; and col. 4, lns. 42-44 and lns. 1-3.

I. The Claims Are Not Anticipated By The Flick Patents

Claims 6 and 15-66 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by a disclosure of tramadol-containing compositions at column 12 of U.S. Pat. No. 3,652,589, in the name of Flick, *et al.* The claims also stand rejected in view of similar disclosure at column 12 of U.S. Pat. No. 3,830,934, also in the name of Flick, *et al.* Applicants request reconsideration of these rejections because the Flick patents do not disclose each and every element recited in the claims.

Each of claims 6, 15, 21, 23, and 55-66, for example, recites a ratio of tramadol to acetaminophen that is neither taught nor suggested by the Flick disclosure. For example, the text appearing at column 12, lines 45-64 of U.S. Pat. No. 3,652,589 not only fails to mention acetaminophen, but also fails to mention any ratio of tramadol to acetaminophen. Although the text appearing at column 12, lines 66-75 does refer to acetaminophen-containing tablets, such tablets are said to have a tramadol to acetaminophen ratio of 1:10[1], which differs from the ratios recited, respectively, in claims 6, 15, and 23 ("about 1:5"), claim 21 ("about 1:1"), and claims 55-66 ("about 1:19 to about 1:50").[2] Since at least these elements are not disclosed in the Flick patents, there is no anticipation as to claims 6, 15, 21, 23, and 55-66. *Verdegaal Bros. v. Union*

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[1] Example 23 discloses tablets that are said to include "25 mg. of the hydrochloride of racemic 1(e)-(m-methoxyphenyl)-2(e)-dimethylamino methyl cyclohexane-1(a)-ol" and "250 mg. of p-acetamina phenol" (as well as pentobarbital sodium and ethoxy benzamide).

[2] Applicants note that the Office Action mistakenly characterizes the cited disclosure in U.S. Pat. No. 3,652,589 as an "actual reduction to practice" (Office Action at page 3, 4, 5, and 7). The text appearing at column 12, lines 45-64 does not refer to preparation of any specific formulation, and the text appearing at column 12, lines 66-75 refers to a prophetic example that Flick did not appear to actually perform (as indicated by Flick's use of the present tense). Accordingly, the cited disclosure does not reflect any "actual reduction to practice," much less an actual reduction to practice of the claimed subject matter.

Oil Co. of Calif., 814 F.2d 628, 631 (Fed. Cir. 1987) (a claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference).

With respect to claims 16-20, 22, and 24-54, the disclosure of the Flick patents differs at least with respect to their inclusion of active ingredients in addition to those recited. For example, whereas each of the claims is directed to pharmaceutical compositions comprising an active ingredient consisting essentially of tramadol and acetaminophen, the only acetaminophen-containing composition that is actually disclosed at column 12 of the Flick patents includes additional active compounds, *i.e.*, pentobarbital sodium and ethoxy benzamide (*see, e.g.*, U.S. Pat. No. 3,652,589 at col. 12, lns. 68-75). Accordingly, there is no anticipation as to claims 16-20, 22, and 24-54.

Although the Office Action suggests that the Flick patents are anticipatory with respect to their disclosure of "a composition containing tramadol and phenacetin" (Office Action at page 3), the patents do not actually disclose such a composition. Rather, what they disclose is that: (1) it is possible to combine tramadol with any of the various members of at least seven classes of therapeutically active agents; and (2) phenacetin is a member of one of the classes (*see, e.g.*, U.S. Pat. No. 3,652,589 at col. 12, lns. 45-61). It is well-established that a broad, non-specific disclosure of this type is not anticipatory with respect to each of the many combinations that one might potentially be able to assemble by picking and choosing among the seven classes, and then among the various members of each class. *In re Schaumann*, 572 F.2d 312, 314 (C.C.P.A. 1978) ("By having to select [a variable] from among the many possibilities which R in the structural formula [of the reference] may be . . . does not give rise to the claimed compound being fully anticipated by the reference."). Accordingly, the Flick patents' disclosure relating to combining tramadol with various therapeutically active agents does not, as a matter of law, anticipate the instant claims.

Even if the Flick patents did disclose "a composition containing tramadol and phenacetin" (Office Action at page 3), such disclosure would not be anticipatory. Indeed, the claims are not directed to compositions that include tramadol and ***phenacetin*** as ingredients, but to pharmaceutical compositions that include tramadol and ***acetaminophen***. Although the Office Action asserts that phenacetin metabolizes into acetaminophen in the body, this fact would still

not support the instant rejection. Indeed, a composition containing tramadol and phenacetin is plainly different from a pharmaceutical composition containing tramadol and acetaminophen, regardless of how the individual ingredients of the latter might metabolize after it is ingested. Accordingly, there can be no anticipation.

Applicant also notes that the Examiner's reliance on *Schering Corp. v. Geneva Pharm.*, Inc., 339 F.3d 1373 (Fed. Cir. 2003) is misplaced. In *Schering*, the court held a compound claim to be anticipated by a prior disclosure relating to ingestion of the compound's metabolic precursor because that compound was necessarily produced when the precursor was ingested. The court specifically distinguished the issue of anticipation of a composition claim from its analysis of anticipation of a compound claim. Thus, under *Schering*, a composition containing two active ingredients would not be anticipated by a disclosure relating to ingestion of a composition comprising one of the active ingredients and a metabolic precursor of the other active ingredient. Moreover, there was evidence in *Schering* that the claimed subject matter (*i.e.* the single compound) would necessarily be present in the body of a patient who had ingested its precursor (*Schering*, 339 F.3d at 1376). In the present case, there is no evidence of record so much as suggesting that the claimed subject matter (*i.e.*, a composition containing both tramadol and acetaminophen) would be present in the body of a patient who had ingested tramadol and phenacetin, much less at the required ratios. In fact, one would surmise that the ingredients of a composition containing tramadol and phenacetin would separate following ingestion, such that neither tramadol and phenacetin (nor tramadol and acetaminophen) would ultimately be associated with one another in a form that could be characterized as a "pharmaceutical composition." Thus, *Schering* is inapposite.

II. The Claims Would Not Have Been Obvious In View Of The Flick Patents

A. The Rejections Based Upon Alleged Disclosure Of A Composition Containing Tramadol And Phenacetin Should Be Withdrawn

Claims 6 and 15-66 stand rejected under 35 U.S.C. § 103(a) in view of the Flick patents' alleged disclosure of a composition containing tramadol and phenacetin (Office Action at pages

5 and 6). Applicants respectfully request reconsideration of this rejection because it is impermissibly based on the hindsight provided by Applicants' own disclosure.

"A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000). To establish a prima facie case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

The Office Action, however, does not identify any reason why a skilled artisan who did not have the benefit of Applicants' disclosure would have been motivated to select tramadol and phenacetin from the Flick patents' broad teaching. As noted above, the patents only teach that tramadol can be combined with the members of seven classes of active agents, and that phenacetin is a member of one of those classes (*see, e.g.*, U.S. Pat. No. 3,652,589 at col. 12, lns. 45-61). The Office Action does not identify any disclosure in the Flick patents that would have directed those of ordinary skill to tramadol and phenacetin, as opposed any of the hundreds of other possible combinations. In fact, Applicants submit that the Examiner was able to focus on phenacetin, and cull it from among the many other active agents recited in the Flick patents, only because he had already read Applicants claims and knew that they were directed to acetaminophen-containing pharmaceutical compositions. Since this sort of hindsight is impermissible in the context of an obviousness analysis, the rejection of Applicants' claims in view of the Flick patents' alleged teaching relating to combinations of tramadol and phenacetin is improper and should be withdrawn. *In re Kotzab*, 55 U.S.P.Q.2d at 1317 ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

Even if it were assumed, for the sake of argument, that those of ordinary skill *would* have been motivated to select phenacetin from the many active agents that the Flick patents disclose (and, moreover, motivated to replace phenacetin with acetaminophen), there is no evidence of record suggesting that those of ordinary skill would have been *further* motivated to prepare pharmaceutical compositions having the claimed proportions of tramadol and acetaminophen. Although the Office Action appears to suggest that motivation to try any and all proportions would have been provided by the patents' alleged disclosure that "a synergistic effect is observed when tramadol is combined with other therapeutically active agents" (Office Action at page 5), the patents' teaching is actually much more limited. Indeed, the patents do not teach that a synergistic effect is observed for all such combinations, but only some of them (*see, e.g.*, U.S. Pat. No. 3,652,589 at col. 12, lns. 45-48). Perhaps even more significant is the fact that the patents fail to so much as suggest which of the hundreds of disclosed combinations are synergistic, and in what ratios. Rather, the patents simply leave one to guess which, if any, exhibit synergy, or to prepare and test the myriad disclosed combinations and then independently make this determination; as the Examiner probably is aware, synergy is very rare in the pharmaceutical field and, in fact, is unpredictable. In any event, the Flick patents' broad disclosure of tramadol-containing combinations falls far short of motivating a person of ordinary skill to prepare Applicants' claimed pharmaceutical compositions. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) (the mere fact that a person of ordinary skill would have found it obvious to try combinations of known reagents does not satisfy the standard of §103.).

B. The Rejections Based Upon Tramadol-Containing Tablets Should Be Withdrawn

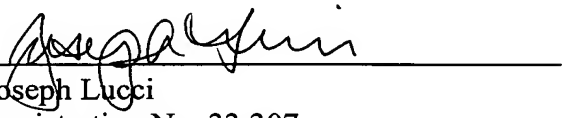
Claims 6 and 15-66 also stand rejected under 35 U.S.C. § 103(a) in view of the tablets disclosed in Example 23 of the Flick patents (Office Action at pages 5 and 7). According to the Office Action, those of ordinary skill would have been motivated to modify the patents' disclosure by "determin[ing] optimum amounts" of tramadol and acetaminophen to be used (Office Action at page 6). Applicants request reconsideration of this rejection because there is no evidence of record indicating that those of ordinary skill actually would have been motivated to make this modification.

The Office Action fails to identify any reason why those of ordinary skill would have been motivated to modify the amounts of tramadol and acetaminophen found in the Flick tablets. Although the Office Action notes that making this modification would have been something that those of ordinary skill would have been *capable* of doing (Office Action at pages 6 and 7), it is well established that much more is required to establish obviousness. The mere possibility that the prior art can be modified or improved does not itself provide the requisite motivation to do so. *In re Dien*, 152 U.S.P.Q. 550 (C.C.P.A. 1967) (incentive to seek improvement of existing process held to not render change made by applicant obvious, even where the change was one capable of being made from theoretical point of view). If it did, then no modification of the prior art would ever lack motivation since some change is always possible. Quite to the contrary, an invention is obvious under the patent laws only when the claimed inventions -- as opposed to the possibility of trying any and all possible modifications -- are actually suggested by the prior art. *In re Shaffer*, 108 U.S.P.Q. 326 (C.C.P.A. 1956) (references, viewed by themselves and not in retrospect, must suggest doing what applicant has done). The Office Action fails to identify any motivation for modifying the Flick tablets; indeed, neither Flick patent so much as mentions the idea of modifying the identity or ratios of agents in the tablets. Accordingly, the rejection for alleged obviousness in view of such modification is improper and should be withdrawn.

Applicants respectfully submit that the claims are in condition for allowance. Favorable consideration and an early notice of allowance are earnestly solicited.

Respectfully submitted,

Date: June 29, 2005



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